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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,701	12/28/2001	Sandra A. Richlen	659-920	5371
7590 06/28/2004				
BRINKS HOFER GILSON & LIONE LTD. P.O. Box 10395 Chicago, IL 60610			EXAMINER REICHLE, KARIN M	
			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/032,701	<b>Applicant(s)</b> RICHLIN ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20,31-40,42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20,31-40,42 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-15-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of the Group II claims in the reply filed on 4-12-04 is acknowledged.
2. The restriction set forth in Paper No. 14 is deemed proper and made FINAL.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

### ***Drawings***

4. The drawings were received on 1-9-04. These drawings are not accepted by the Examiner. See, e.g., the remarks set forth in paragraph 5 of the last Office Action, Paper No. 14.
5. The drawings are objected to because in Figures 17 and 18 the extraneous text should be avoided, i.e. such should be included in the detailed description instead. In Figure 3, the lines and arrows from 145 should be dashed to indicate underlying structure. The right hand side of Figure 14 is unclear. The lines from 51 should be dashed. In Figures 12 and 13, the numeral 128 should denote the same surface as shown in Figures 3-9B. In Figures 15-16, a line each numeral, e.g. 45 and 49, to the structure it denotes should be provided. Also the lines from and

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lines forming underlying structure, e.g. the lines from 14 and 16, elastics 36 and 38, sides 74 and layer 72, should be dashed. In Figure 16, the leg elastics are denoted both 36 and 38. In Figure 16, on the right side, the line from 37 should be dashed. Where is 70 as set forth on page 33, lines 30-31 shown? Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Description***

6. The use of the trademark Velcro(page 39, line 9) and lycra( page 37, line 4) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters or with a symbol but not both.

### ***Claim Language Interpretation***

7. The directional terms are defined as set forth on page 5, lines 4-27. "Releasably engaged" is defined as set forth on page 6, lines 12-19. "Fixedly secured" is defined as set forth on page 6, lines 20-24. "Line of weakness" is defined as set forth on page 7, lines 12-20. "Body panel" is defined as set forth on page 18, lines 3-7. "Nonwoven" is defined as set forth in the sentence bridging pages 19-20. Attention is invited to the paragraph bridging pages 25-26, i.e. while the testing protocol on pages 36 et seq is preferred it is not required, i.e. the claims do not limit the testing protocol to that set forth on pages 36 et seq. It is also noted that the length of the panel, see discussion of the testing protocols, has not been set forth. It is noted that the body panel is not limited to a single layer of material, i.e. line of weakness can be in only one layer of a multilayer panel as claimed. Also note that a fastener is claimed only in claims 16 and 35 and page 1, lines 5-19 and page 2, lines 15-18.

### ***Claim Rejections - 35 USC § 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 11-20, and 31-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Igaue et al GB '024.

Claims 11-20: See claim language interpretation section supra and Igaue et al at Figures, abstract, lines 3 et seq, page 2, last paragraph, page 9, line 17-page 11, line 2. The front panel is 1, the rear panel is 2 and is connected to the front panel by seam 8, the line of weakness is 9b, the elastomeric material is 14-15 and the fastener member is 5 and 6. Therefore, the Igaue reference clearly teaches all the claimed limitations except for the specific tear and tensile strengths. On page 2, lines 15-18 of the instant disclosure, Applicants set forth the purpose of the tensile and tear strengths is to allow breakage along a line of weakness to convert a pant-type garment to an open product without undue effort (It is noted that the terminology "undue effort" is considered relative). The claimed strengths are disclosed as those preferred. While Igaue et al does not teach the strengths (see Claim Language Interpretation section supra), see the portions of the Igaue reference cited supra which also teach an absorbent garment which converts from a pant-type garment into an open product simply by providing a line of weakness, i.e. a tear line, so as to allow the user to tear, i.e. break, the garment along such line. Thus, and additionally considering the lack of claiming a specific testing protocol, it is the Examiner's first position that there is sufficient factual basis for one to conclude that the Igaue et al panel would inherently include the claimed strengths when tested, at the very least, according to some testing protocol,

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and, at the very most, according to Applicant's preferred testing protocol. Note MPEP 2112.01. In any case, it is the Examiner's second position that even if the Igaue reference does not include the exact strength ranges, the general conditions of the claim are disclosed by the Igaue, see discussion of Applicant's purpose and the purpose of Igaue supra, and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, In re Allen. 105 USPQ 233 (CCPA 1955). Finally, it is Examiner's third position that the claims are product by process claims and test characteristic claims, i.e. rather than setting forth the specific structure and composition of the panel and line of weakness, the claims define the end product by physical characteristics thereof which are determined by a test, i.e. equipment and process, used to measure such. As set forth in MPEP 2113, even though product by process claims are limited by and defined by the process, i.e. the processing of testing here, determination of patentability is based on the product itself, i.e. the end product. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by another process. As discussed supra, since the structure of the panel and line of weakness are not specifically set forth and the test used to determine the strengths is not specifically set forth, the end product as best understood is a panel with a line of weakness which will perform the purpose set forth by Applicants, discussed supra. Since such a product appears to be the same or similar to that of Igaue et al, see discussion supra, the claims are considered unpatentable.

With regard to claims 31-40, the steps of the method are, inherently are or necessarily and inevitably performed during use of the Igaue et al device. See MPEP 2112.02.

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11. Claims 11-15, 17-20, 31-34, 36-40, 42 and 44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pozniak et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 11-15, 17-20 and 42: See claim language interpretation section *supra* and Pozniak et al at Figures, abstract, col. 11, lines 38-65, col. 8, lines 24-27 and col. 14, lines 29-45. The front panel is 70, the rear panel is 72 and is connected to the front panel by seam 74, the line of weakness is 62, the panels may comprise a nonwoven spunbond or elastomeric material and the chassis is 20 (It should be noted that the dimensions of the panels are not specifically claimed). Therefore, the Pozniak reference clearly teaches all the claimed limitations except for the specific tear and tensile strengths. On page 2, lines 15-18 of the instant disclosure, Applicants set forth the purpose of the tensile and tear strengths is to allow breakage along a line of weakness to convert a pant-type garment to an open product without undue effort (It is noted that the terminology “undue effort” is considered relative). The claimed strengths are disclosed as those preferred. While Pozniak et al does not teach the strengths (see Claim Language Interpretation section *supra*), see the portions of the Pozniak reference cited *supra* which also teach an absorbent garment which converts from a pant-type garment into an open product simply by providing a line of weakness, i.e. a tear line, so as to allow the user to tear, i.e. break, the garment along such line. Thus, and additionally considering the lack of claiming a specific testing protocol, it is the Examiner’s first position that there is sufficient factual basis for one to conclude that the Pozniak et al panel would inherently include the claimed strengths when tested, at the very least, according to some testing protocol, and, at the very most, according to Applicant’s preferred testing protocol. Note MPEP 2112.01. In any case, it is the Examiner’s second position that even if the Pozniak reference does not include the exact strength ranges, the general conditions of the claim are disclosed by the Pozniak, see discussion of Applicant’s purpose and the purpose of Pozniak *supra*, and it is not inventive, i.e. it would be obvious to one

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of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Allen*, 105 USPQ 233 (CCPA 1955). Finally, it is Examiner's third position that the claims are product by process claims and test characteristic claims, i.e. rather than setting forth the specific structure and composition of the panel and line of weakness, the claims define the end product by physical characteristics thereof which are determined by a test, i.e. equipment and process, used to measure such. As set forth in MPEP 2113, even though product by process claims are limited by and defined by the process, i.e. the processing of testing here, determination of patentability is based on the product itself, i.e. the end product. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by another process. As discussed supra, since the structure of the panel and line of weakness are not specifically set forth and the test used to determine the strengths is not specifically set forth, the end product as best understood is a panel with a line of weakness which will perform the purpose set forth by Applicants, discussed supra. Since such a product appears to be the same or similar to that of Pozniak et al, see discussion supra, the claims are considered unpatentable.

With regard to claims 31-34, 36-40 and 44, the steps of the method are, inherently are or necessarily and inevitably performed during use of the Pozniak et al device. See MPEP 2112.02.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 11-15, 17-20, 31-34, 36-40, 42 and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,508,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the filing date of the instant application is after that of the patent, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. The claims of the instant application are broader than the claims of the patent except for the claiming of the strengths. With regard to the strengths see the prior art rejection *supra* as well as the independent claims of the patent. As regards the broader features, once an Applicant has received a patent for a species, he/she is not entitled to a patent for the broader or generic invention. This is because the more specific anticipates the broader, i.e. the patented claims anticipate the application claims, see *In re Goodman*, *supra*.

#### ***Common Ownership***

14. Claims 11-15, 17-20, 31-34, 36-40, 42 and 44 are directed to an invention not patentably distinct from claims 1-33 of commonly assigned 6, 508,797. Specifically, see rejections *supra*.

15. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 6,508,797, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

#### ***Response to Arguments***

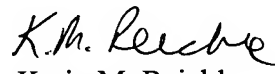
16. Applicant's 1-9-04 remarks have been noted but are either deemed moot in that the issue has not been reraised or deemed not persuasive for the reasons set forth supra.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
June 24, 2004